

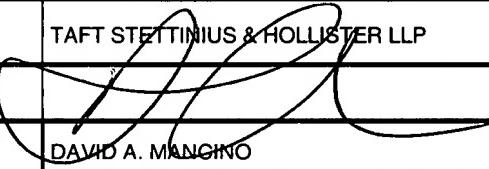
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		Filing Date	08-31-01
		First Named Inventor	GRAHAM, ET AL
		Art Unit	3622
		Examiner Name	BEKERMAN, MICHAEL
Total Number of Pages in This Submission	6	Attorney Docket Number	CGR03-GN003

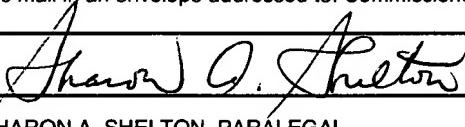
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Firm Name	TAFT STETTINIUS & HOLLISTER LLP		
Signature			
Printed name	DAVID A. MANCINO		
Date	09-26-2007	Reg. No.	39,289

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Sharon Shelton

**PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Applicant : Graham, et al.  
Filed : August 31, 2001  
Serial No. : 09/945,378  
Title : COMPUTERIZED SYSTEM AND METHOD FOR PROVIDING ADVERTISING TO A CONSUMER  
Docket No. : CGR03-GN003  
Examiner : Bekerman, Michael  
Art Unit : 3622  
Tech. Center : 3600

Hon. Commissioner for Patents  
Alexandria, VA 22313

Dear Sir:

**REPLY BRIEF**

The instant appeal is from a final rejection dated September 6, 2006. This Reply Brief is timely submitted in accordance with 37 C.F.R. § 41.41 and is in response to the Examiner's Answer mailed September 11, 2007.

I. **McIntyre Does Not Disclose The Element For Which It is Cited.**

Contrary to the Examiner's assertions,<sup>1</sup> McIntyre<sup>2</sup> does not disclose the step of the rejected claims for which it is cited: "providing the statistical report to the commercial entity." In fact, the portion of McIntyre cited by the Examiner merely describes a "software program keeping track of the number of times contest information is provided on behalf of one of said sponsors and allocating a cost to each of said sponsors on which contest information has been provided."<sup>3</sup> Because the none of the cited combinations of references discloses the above-mentioned claim element, each of the 35 U.S.C. § 103(a) rejections at issue in this appeal is improper.

In an attempt to remedy this deficiency, the Examiner argues that "[t]he act of billing inherently comprises providing certain key information to the entity being billed"<sup>4</sup> and, therefore, a bill based on a number of times an advertisement is viewed should be considered a statistical report. This argument ignores the Office's own guidance pertaining to inherency: "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."<sup>5</sup>

While a bill based on the number of times an advertisement is viewed may include a statistical report, such a statistical report is not "necessarily present"<sup>6</sup> in such a bill. For example, a bill for advertising may merely indicate a balance

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<sup>1</sup> Examiner's Answer page 3 ("McIntyre teaches a statistical report that keeps track of how many times a game is played and the sending of this report to the sponsors of the game (Paragraph 0008).").

<sup>2</sup> U.S. Patent Application Publication No. 2003/0191690.

<sup>3</sup> U.S. Patent Application Publication No. 2003/0191690 paragraph [0008].

<sup>4</sup> Examiner's Answer page 3.

<sup>5</sup> MPEP 2112.IV (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981)).

<sup>6</sup> See MEPE 2112.IV (citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) ("To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'").

due. If such a balance due is calculated using factors in addition to the number of times an advertisement was viewed, it would be unreasonable to term the bill a "statistical report" as no statistical information, other than a total amount due, could be gleaned from it. As McIntyre does not disclose, for example, a bill showing a cost breakdown or a bill based solely on the number of times an advertisement is viewed, McIntyre does not inherently disclose the step of "providing the statistical report to the commercial entity." Accordingly, this element of the claims is not disclosed in the cited combinations of prior art and each of claim rejections under 35 U.S.C. § 103(a) should be reversed.

**II. The Material Printed On The Statistical Report Is Functionally Related To The Claimed Method.**

Despite the Examiner's argument that claims 64-65 and 68-70 "simply set forth the type of information conveyed in the report"<sup>7</sup> and his conclusory statement that "the illustrated information is simply non-functional descriptive material,"<sup>8</sup> claims 64-65 and 68-70 include proper functional limitations.

As an example, claim 64 is dependent upon claim 33 and, therefore, includes all of the limitations of claim 33. As such, "the statistical report" in claim 64 refers to "the statistical report" of claim 33. In claim 33, "the statistical report" is generated from data associated with the consumer's interactions with the interactive advertising. Therefore, for the statistical report to illustrate the number of first-time accesses of consumers to the interactive advertising message over a period of time (as required by claim 64), the gathering and generating steps must include data pertaining to the number of first-time accesses over that period of time. As such, varying the information to be illustrated in the statistical report affects the scope of the data gathered and the generation of the report. Thus, the method is not be performed exactly the same for reports illustrating different information and the illustrated information is not "simply non-functional

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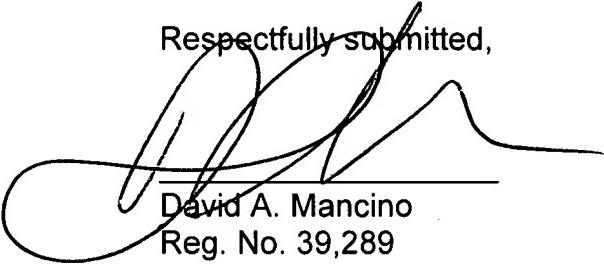
<sup>7</sup> Examiner's Answer page 8.

<sup>8</sup> Examiner's Answer page 8.

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descriptive material." Accordingly, the rejection of claims 64-65 and 68-70 should be reversed as the cited combination of references does not teach such data content.

Respectfully submitted,

  
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